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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,849	01/07/2005	Kenichiro Miyahara	Y04S022	7212

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EXAMINER

AUSTIN, AARON

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/516,849

Applicant(s)

MIYAHARA, KENICHIRO

Examiner

Aaron S. Austin

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 11/320873 in view of Utsumi et al. (US Patent No. 5,766,783) and Japanese Patent No. 404092865A (JP '865). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are encompassed by the claims of the copending application. Specifically, both claim a sintered compact substrate for forming a thin film. They differ in that the thin film is included in the present claims as elements of intended use whereas the copending Application claims the very same elements. Therefore, as the copending application clearly teaches

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application of a thin film to a substrate with the very same elements claimed in the present application, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to apply the elements claimed in the preamble as intended use to the claimed substrate and thereby create the claimed substrate and film of the copending application.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka et al. (US Patent No. 6,001,748).

Tanaka et al. teach aluminum, gallium and indium crystal nitride layers formed on the surface of a substrate composed of a sintered product of aluminum nitride (column 6, lines 32-65; claims 6 and 19).

Please note, these claims are directed to a substrate for thin film formation. Therefore, the thin film and its elements are considered intended use.

Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka et al. (US Patent No. 6,001,748) with support from Utsumi et al. (US Patent No. 5,766,783). See MPEP 2131.01.

Tanaka et al. teach aluminum, gallium and indium crystal nitride layers formed on the surface of a substrate composed of a sintered product of aluminum nitride (column 6, lines 32-65; claims 6 and 19). The crystal's structure is of the wurtzite type, a hexagonal structure (column 6, lines 53-65). Further, aluminum nitride (AlN) has a crystal structure of the wurtzite type belonging to hexagonal symmetry (see Utsumi et al. column 1, lines 21-31).

Please note, these claims are directed to a substrate for thin film formation. Therefore, the thin film and its elements are considered intended use.

Claim 3 is rejected under 35 U.S.C. 102(b) as being anticipated by Tanaka et al. (US Patent No. 6,001,748) with support from Japanese Patent No. 404092865A (JP '865). See MPEP 2131.01.

Tanaka et al. teach aluminum, gallium and indium crystal nitride layers formed on the surface of a substrate composed of a sintered product of aluminum nitride (column 6, lines 32-65; claims 6 and 19). An AlN sintered compact will have optical permeability (see JP '865).

Please note, these claims are directed to a substrate for thin film formation. Therefore, the thin film and its elements are considered intended use.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Aida et al. (US Patent No. 5,668,524).

Aida et al. teach an AlN film formed on the surface of a substrate composed of a sintered product of aluminum nitride (Example 1: column 12, lines 9-10).

Please note, these claims are directed to a substrate for thin film formation. Therefore, the thin film and its elements are considered intended use.

Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Aida et al. (US Patent No. 5,668,524) with support from Utsumi et al. (US Patent No. 5,766,783). See MPEP 2131.01.

Aida et al. teach an AlN film formed on the surface of a substrate composed of a sintered product of aluminum nitride (Example 1: column 12, lines 9-10). Further, aluminum nitride (AlN) has a crystal structure of the wurtzite type belonging to hexagonal symmetry (see Utsumi et al. column 1, lines 21-31).

Please note, these claims are directed to a substrate for thin film formation. Therefore, the thin film and its elements are considered intended use.

Claims 2-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Aida et al. (US Patent No. 5,668,524) with support from Japanese Patent No. 404092865A (JP '865). See MPEP 2131.01.

Aida et al. teach an AlN film formed on the surface of a substrate composed of a sintered product of aluminum nitride (Example 1: column 12, lines 9-10). An AlN sintered compact will have optical permeability (see JP '865).

Please note, these claims are directed to a substrate for thin film formation.
Therefore, the thin film and its elements are considered intended use.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron S. Austin whose telephone number is (571) 272-8935. The examiner can normally be reached on Monday-Friday: 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ASA


JENNIFER C. MCNEIL
SUPERVISORY PATENT EXAMINER
8/2/06